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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/674,877	01/02/2001	Gerhard Hocfle	6013-192	5629

20999 7590 07/22/2003

FROMMER LAWRENCE & HAUG
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NEW YORK, NY 10151

EXAMINER

AULAKH, CHARANJIT

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 07/22/2003

19

Please find below and/or attached an Office communication concerning this application or proceeding.

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DETAILED ACTION

1. According to paper no. 18 filed on May 22, 2003, the applicants have amended claims 1-5, 7-14 and 22-24 and furthermore, have added new claim 25.
2. Claims 1-14, 18-20 and 22-25 are now pending in the application.

Response to Arguments

3. Applicant's arguments with respect to claims 3-8, 11-14, 18-20 and 22-24 have been considered but are moot in view of the new ground(s) of rejection. The applicants have amended claims to overcome all indefiniteness and prior art rejections.

NEW GROUNDS OF REJECTION

Claim Objections

4. Claims 9 and 10 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in alternative only. See MPEP § 608.01(n).

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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6. Claims 4, 6-12, 24 and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 4, the values of variables R4, R5 and R6 are listed as ---defined as R1 in claim 1, but are independent of R1----. The value of variable R1 is defined in claim 4 itself (see first line under structure) and is essentially same as defined in claim 1. It is not clear why depend upon claim 1 for value of variable R1. Also, it is not clear what is the intent of ---but are independent of R1---.

In claims 4, 8, 11, 12 and 24, the term --- provided with---- is vague. The applicants are suggested to use the term ---- optionally substituted with -----.

Claim 6 depends upon claims 1-5 and 22 and still refers to epothilone derivative. This term has been changed to --a compound-- by last amendment. An appropriate correction is required.

In claims 7, 8 and 24, it is not clear what is meant by the term ---respectively?----.

In claims 9 and 10, the terms ---characterised in---- and ---production--- are vague. The applicants are suggested to use the terms --- wherein ---- and ---preparing or preparation----, respectively.

In claim 7, the monocyclic aromatic and/or heteroaromatic rings are substituted with alkyl groups and halogens or alkyl groups or halogens. Clarification is needed.

In claim 25, the monocyclic aromatic and/or heteroaromatic rings are substituted with C1-4 alkyl, C2-4-alkenyl and C2-4-alkynylgroups or should it be C1-4 alkyl, C2-4-alkenyl or C2-4-alkynylgroups? Clarification is needed.

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Allowable Subject Matter

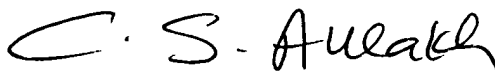
7. Claims 5, 13, 14, 18, 19, 22 and 23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. Claims 1-3 and 20 are allowed.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chana Aulakh whose telephone number is (703) 305-4482. The examiner can normally be reached on "Monday-Thursday" from 7:30 A.M. to 6:00 P.M.

If the attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Alan Rotman, can be reached on (703) 308-4698. The fax number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group's receptionist whose telephone number is (703) 308-1235.



CHARANJIT S. AULAKH

PRIMARY EXAMINER

Office Action Summary

Application No.
09/674,877

Applicant(s)
Hoeffle, G. et al.

Examiner
CHARANJIT AULAKH

Art Unit
1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on May 22, 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14, 18-20, and 22-25 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3 and 20 is/are allowed.
- 6) ☒ Claim(s) 4, 6-12, 24, and 25 is/are rejected.
- 7) ☒ Claim(s) 5, 13, 14, 18, 19, 22, and 23 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ | 6) <input type="checkbox"/> Other: |